

App. No. 09/862,391
Amendment B
Page 6

R E M A R K S

Reconsideration of the present application in view of the following remarks is respectfully requested. Thirteen claims are pending in the application: Claims 1 through 13.

35 U.S.C. § 102

Claims 1-13 stand rejected under 35 U.S.C. 102(b) as being anticipated by DTV: The Next Generation.

DTV: The Next Generation was submitted in an Information Disclosure Statement on May 12, 2004. The date listed in the Information Disclosure Statement for the reference was April 28, 2000.

As stated in 37 C.F.R. 1.97(h) "The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b)." Additionally, M.P.E.P. section 2129 states "Mere listing of a reference in an information disclosure statement is not taken as an admission that the reference is prior art against the claims. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354-55, 66 USPQ2d 1331, 1337-38 (Fed Cir. 2003) (listing of applicant's own prior patent in an IDS does not make it available as prior art absent a statutory basis); see also 37 CFR 1.97(h) ("The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).")." Thus, the mere submission of the reference "DTV: The Next Generation" in the

App. No. 09/862,391
Amendment B
Page 7

Information Disclosure Statement, does not make it available as prior art, absent a statutory basis.

"April 28, 2000[, the date listed in the Information Disclosure Statement for the reference 'DTV: The Next Generation',] was the date of an internal presentation was made to a group of Sony employees at a Sony Technical Symposium." And, to the knowledge of the inventor, "'DTV: The Next Generation' was never presented or made available to anyone who was not employed by Sony more than one year prior to the filing date of the present application." Thus, the April 28, 2000 date cited in the Information Disclosure Statement, and by the Examiner, was not a date on which the reference "DTV: The Next Generation" was "published" under 35 U.S.C. § 102(b). Applicant therefore submits that the reference "DTV: The Next Generation" does not qualify as a printed publication under 102(b) and thus the rejection of Claims 1 through 13 lacks a statutory basis.

Therefore, Applicants respectfully submit the rejection is overcome and claims 1 through 13 are in condition for allowance.

App. No. 09/862,391
Amendment B
Page 8

C O N C L U S I O N

In view of the above, Applicants submit that the pending claims are in condition for allowance, and prompt and favorable action is earnestly solicited. Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Thomas F. Lebens at (805) 781-2865 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,



Martin R. Bader
Reg. No. 54,736

Dated: October 28, 2004

Address all correspondence to:

FITCH, EVEN, TABIN & FLANNERY
120 South LaSalle Street, Ste. 1600
Chicago, IL 60603
(858) 552-1311